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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,250	08/15/2003	Keith William Hutcheon	188472 (8830-220)	1546

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DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

EXAMINER

HALE, GLORIA M

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/642,250	Applicant(s) HUTCHEON ET AL	
	Examiner Gloria Hale	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9-14-05 Amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4,6-15 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4,6-15 and 17-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-4, 6-15 and 17-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is unclear in regard to the attachment of the cover to the suit. The recitation "around a periphery of the cover around the valve" is unclear. It is not clear if the cover is attached around the periphery of the cover or also the periphery of the valve. It is also not clear as to which direction the tubular configuration extends. Applicant has not adequately claimed the exact structure of the "tubular cover". Applicant's invention is actually a cone-shaped cover with a base end that is peripherally attached to the immersion suit about a periphery of a valve and wherein the tubular or cone-shaped extension extends away from the suit and has an open opposite end. The present claims are still broad and do not clearly define the structure of applicant's cover. In claim 15 it is also not clear as to how the cover "folds" over the valve. No structure has been claimed to define what structure performs the functional limitation as claimed. The seamed structure or folds themselves should be claimed. In claim 3 it is not clear as to what structure allows the connecting portion to resist flow. In claim 4 it is not clear as to what structure allows the deformation other than the material of the cover itself. In claim 24 it is not clear as to what structure performs the deformation other than the

material itself. If another structural element aids the deformation it should be claimed. It is not clear as to how the cover “folds” over the valve other than the bending of the fabric itself since no other structure has been claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 4, 6-12, 15, 17-19 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (US 3,931,657).

Jones discloses the immersion suit 10 as seen in figure 1 as broadly claimed and as best understood. No structure defining the immersion suit other than the preamble has been included in the claim. Jones discloses a valve 40 with a cover 41 permanently attached to the suit by stitching around the valve and which is deformable or foldable over the valve upon force yet protects it from an external force as broadly claimed. The cover comprises a base end (the closed end), a head (the open end or corner) and a connecting portion (the connecting linear tube-like portion) all not numbered as seen in figure 1 and as described in col. 3, lines 28-35). The cover is deformable since it is of a bendable fabric. The base dimension, the perimeter stitched to the suit is greater than the dimension of the head or upper end that is the upper corner. The tubular shape tapers from the base (the stitched perimeter) to the head end (the curved top and open corner) and is frusto-conical in shape as seen in figure 1 in the lengthwise direction.

The cross-section of the base is polygonal when the corner is folded as seen in figure 1. The head end cross-section is substantially circular about the tubular tubing when supported by the tubing. The head end has reduced snagging due to the fold and ability of the material to fold. The connecting portion extends away from the suit which allows the tubing and valve to be placed therein as seen in figure 1. The base end is secured to the suit about the valve with the valve in communication with the base (open end as seen in figure 1) of the cover as in claim 18. The cover folds over and protects the valve as claimed in claim 19. The valve of Jones is an air exhaust valve as in claim 21 since it deflated the bladder. (See Jones col. 3, lines 26-29). The flap is held closed and the connecting portion is structured as broadly claimed. (See Jones, col. 3, lines 30-35) as claimed in claim 20. When the cover adopts the second open shape air is permitted to escape as claimed in claim 22. Fluid, such as when a person is in the body of water, will cause a shearing action to cover the valve with the cover as in claim 23. The lower end contacts the body of water when a wearer is immersed and would close the flap upwardly to protect the valves.

Response to Arguments

Applicant's arguments with respect to claims 15 and 24 have been considered but are moot in view of the new ground(s) of rejection and in light of the amendments. It is well noted that the extremely broad independent claims as originally filed have been amended. However, the present claims, as broadly interpreted, do not claim applicant's invention with the limitations necessary to overcome the prior art. Applicant is narrowly interpreting the claims and is reading structural limitations into the claims

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that are not clearly present. Each structural element of the invention must be clearly and adequately claimed. Deficiencies have been described above in regard to 35 USC 112. In order to define applicant's invention over the prior art the structural elements of the "immersion suit" must be clearly claimed in addition to the valve and the exact structure of the cover describing exactly how it is connected to the suit and its exact shape. The structure that allows the "folding" must be claimed in the independent claims. The present claim 15 only claims a "suit" with a "valve" with a "substantially tubular cover" that is foldable. This structure is clearly seen in Jones.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria Hale whose telephone number is 571-272-4984. The examiner can normally be reached on Tues.-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 571-272-4983. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gloria Hale

GLORIA M. HALE
PRIMARY EXAMINER